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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,704	01/31/2001	Daniel O. Jones	PLUG-0056-US (734)	7911

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Fred G. Pruner, Jr.  
TROP, PRUNER & HU, P.C.  
Ste, 100  
8554 Katy Freeway  
Houston, TX 77024

EXAMINER

ALEJANDRO, RAYMOND

ART UNIT	PAPER NUMBER
1745	10

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

17G

<b>Advisory Action</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/773,704	JONES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Raymond Alejandro	1745

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_.

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: refer to next page.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_.

Claim(s) objected to: \_\_\_\_.

Claim(s) rejected: 1-8 and 19.

Claim(s) withdrawn from consideration: \_\_\_\_.

8.  The proposed drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.
9.  Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_.
10.  Other: \_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see paper # 9, filed 03/07/03, with respect to the rejection(s) of claim(s) 1-8 and 19 have been fully considered and are not persuasive. Therefore, the rejection has been herein maintained for the reasons of record.
2. Regarding the assertion that the prior art teaches "all routing all excess energy to a battery", it is noted that such prior art's teaching of "routing all excess energy to a battery", (as admitted by the applicants; and based on the claim language standpoint), meets the bounds and metes set forth by the instant claim language. In that, it is contended that such "excess energy" might be considered to be some of the remaining power (not consumed) which is produced by the cell stack. Accordingly, one of ordinary skill in art would obviously recognize that whatever power produced by the fuel cell stack and being consumed by a first load cannot be also consumed by a second load, hence, it is apparent from the claim language (and its implication) that "the power not consumed by the first load" is fully available to be employed or routed to a different energy-requiring load to which the fuel cell per se is connected or from which power is directed therefrom. Since the claim language per se does not specifically define what particular "amount" or "percent" of power is intended by the recitation "the power produced by the fuel cell stack and not consumed by the first load", it is thus understood that any remaining power which is not consumed by the first load is hence usable, vacant or free so as to be fully or partly utilizable anywhere in the fuel cell system.
3. With respect to the assertion that there is no support for the alleged suggestion or motivation to combine both references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are directed to method of operating fuel cell system exhibiting changeable load conditions. Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

4. As for the limitation of selectively routing at least some of the produced power. In this regard, it is also contended that applicants recognize that the prior art discloses "automatically routing electric power". *In that, the examiner likes to contend that while the term "automatically" might imply that it is acting or done spontaneously, such term "automatically", for instance, also implies having a self-acting or self-regulated mechanism. That is to say, a state or condition in which activity or behavior (of system) is regulated automatically in a predetermined manner.* Accordingly, it is understood that while the method of the prior art can be performing steps automatically, there must exist a discriminating sequence (order), or operational subroutine or programmable succession in which such steps are strictly required to be performed based on pre-set operating conditions which are necessitated as to obtaining a continuing, adequate and satisfactory fuel cell functionality without affecting the overall system

performance, and inherently, its method of operation. Hence, the automatic step of the prior art inherently includes determining or discriminating steps and/or conditions. Thus, the burden is shifted to applicants to provide objective evidence demonstrating the claimed method is necessarily different from the prior art's method, and that the difference is unobvious.



STEPHEN K. LASUT  
PRIMARY EXAMINER  
GROUP  
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